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10/588,593	06/11/2007	Shigenobu Kishi	0388-062233	8725

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EXAMINER
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JACOBSON, MICHELE LYNN

ART UNIT	PAPER NUMBER
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1782

MAIL DATE	DELIVERY MODE
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08/31/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/588,593	<b>Applicant(s)</b> KISHI ET AL.	
	<b>Examiner</b> MICHELE JACOBSON	<b>Art Unit</b> 1782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/15/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-4 in the reply filed on 8/9/10 is acknowledged. The traversal is on the ground(s) that there is no undue burden on the examiner to examine the inventions of groups I and II together. This is not found persuasive because the standard for restriction of claims in applications filed under the articles of the Patent Cooperation Treaty does not address "undue burden" and instead relies on the lack of unity of invention. Applicant has failed to provide arguments to negate the lack of unity of invention set forth by the examiner in the restriction requirement mailed 7/7/10. Therefore, applicant's arguments are not found persuasive.

2. Claims 5-9 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8/9/10.

3. The requirement is still deemed proper and is therefore made FINAL.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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6. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1 and 4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15 and 16 of copending Application No. 10/525914. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instantly pending claims would have been obvious over claims 15 and 16 of copending Application No. 10/525914.

8. Copending Application No. 10/525914 teaches a container stopper comprising a core formed of an elastic material and having a liquid-contact surface and an outer peripheral surface continuous with the liquid-contact surface coated with a skin made of a synthetic resin, wherein said skin is a skin made of one of a polyester resin and a synthetic resin having a polyester resin as a main component thereof, and the skin is bonded to the liquid-contact surface and the outer peripheral surface of said core through a bonding layer, wherein said bonding layer is a polyethylene bonding layer and wherein said skin is a skin made of polyethylene terephthalate.

9. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have varied the result effective variable of thickness of the bonding layer depending on the thickness of bonding layer/skin layer coating desired. This obvious modification of copending Application No. 10/525914 would have produced the same invention as claimed in claims 1 and 4.

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10. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte*

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*Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation that the polyethylene bonding layer has a “thickness of 30  $\mu\text{m}$  or more over the entire liquid-contact surface”, and the claim also recites that the polyethylene bonding layer “has a thickness of 80 to 300  $\mu\text{m}$  at a center portion of the liquid-contact surface” which is the narrower statement of the range/limitation since the “center portion” of the liquid-contact surface falls within the “entire liquid-contact surface”. For the purpose of examination, claim 1 will be interpreted to recite the broader recitation. Claims 2-4 are rejected as being dependent from indefinite claim 1. Appropriate correction is required.

14. Claim 1 is also indefinite for the recitation of “a center portion of the liquid-contact surface”. It is unclear from this recitation what region of the liquid-contact surface is the “center portion”. Additionally, there is insufficient antecedent basis for this limitation in the claim since the “liquid-contact surface” is not positively recited to comprise a “center portion”. How much of the liquid-contact surface is intended to be interpreted as the “center portion”? Since it is unclear what region is being referred to, one of ordinary skill in the art would not have been reasonably apprised of the full breadth and scope of the invention claimed in claim 1. The thickness at the “center portion” of the liquid contact surface will be interpreted as set forth above for the purpose of examination. Claims 2-4 are rejected as being dependent from indefinite claim 1. Appropriate clarification is required.

15. Claim 2 is indefinite for the recitation “wherein the thickness of said polyethylene bonding layer is 10  $\mu\text{m}$  or more greater than the thickness of the polyethylene bonding

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layer at the outer peripheral portion". It is unclear how the thickness of the "polyethylene bonding layer", which *includes* the polyethylene bonding layer at the outer peripheral portion, can be 10 µm or more thicker than the polyethylene bonding layer **at** the outer peripheral portion. Since it is unclear what thickness are being compared in claim 2, it is impossible to examine claim 2 on the merits

### ***Claim Objections***

16. Claim 3 objected to because of the following informalities: Claim 3 recites "the polyethylene bonding layer at the outer peripheral surface comprises **a** one layer". This is grammatically incorrect. The examiner believes applicant intended to recite "the polyethylene bonding layer at the outer peripheral surface comprises one layer".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.



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18. Claims 1, 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor WO 03/074379 (hereafter referred to as Taylor).

19. Taylor teaches a stopper made of cork or plastic comprising a barrier layer which comprises hot melt polymeric adhesive such as polyethylene. (Pg. 5, 6, 10) The barrier layer preferably has thickness of from 0.075 to 50  $\mu\text{m}$ . (Pg. 5) The barrier layer may extend beyond the edge of the stopper by up to about 200  $\mu\text{m}$  such that it forms a gasket with the inner wall of the receptacle. (Pg. 6-7)

20. The barrier layer may also be a composite layer comprising at least one hot melt polymeric adhesive sub-layer and at least one sub-layer having lower oxygen permeability than the hot melt adhesive. (Pg. 8) Such lower permeability materials include polyethylene terephthalate (PET). (Pg. 9) Where multiple sub-layers are present in the barrier layer, a hot melt adhesive sub-layer will preferably be located against the material of the stopper. (Pg. 8)

21. Regarding claim 1: Taylor anticipates the container stopper comprising a core of elastic material comprising a polyester layer bonded to the core by a polyethylene layer greater than 30  $\mu\text{m}$  thick as claimed in claim 1.

22. Regarding claim 3: The multilayer barrier layer embodiment of Taylor anticipates the invention claimed in claim 3 since the embodiment comprising two polyethylene layers of Taylor reads on both limitations in claim 3 since a bonding layer at the outer peripheral surface *comprising* one layer may also include additional layers.

23. Regarding claim 4: Taylor clearly recites PET.

***Claim Rejections - 35 USC § 103***

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claim 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakada et al. WO 2004/020300 (hereafter referred to as Nakada), U.S. Patent Application Publication No. 2006/0151424 relied on herein for translation and reference.

26. Nakada teaches a container stopper comprising a core formed of an elastic material and having a liquid-contact surface and an outer peripheral surface continuous with the liquid-contact surface coated with a skin made of a synthetic resin, wherein said skin is a skin made of a polyester resin or a synthetic resin having a polyester resin as a main component thereof, and the skin is bonded to the liquid-contact surface and the outer peripheral surface of said core through a bonding layer. (Para. 10) The bonding layer is disclosed to be a polyethylene bonding layer. (Para. 17) The skin layer is disclosed to be PET. (Para. 16) In one embodiment of the invention, the polyethylene bonding layer is disclosed to comprise a polyethylene adhesive film and a polyethylene film. (Para. 53)

27. Regarding claims 1 and 4: It would have been obvious to one having ordinary skill in the art at the time the invention was made to have varied the result effective variable of thickness of the bonding layer depending on the thickness of bonding

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layer/skin layer coating desired. This obvious modification of Nakada would have produced the same invention as claimed in claims 1 and 4.

28. Regarding claim 3: The embodiment of Nakada wherein the polyethylene bonding layer is disclosed to comprise a polyethylene adhesive film and a polyethylene film reads on both limitations of claim 3 since a bonding layer at the outer peripheral surface *comprising* one layer may also include additional layers.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE JACOBSON whose telephone number is (571)272-8905. The examiner can normally be reached on Monday-Thursday 8:30 AM-7 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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